

## REMARKS

Claims 1, 3-24 are pending in the present application. Claims 1 is currently amended. Thus, upon entry of the present amendment, claims 1 and 3-24 will be subject to examination.

### **A. Regarding the Amendments to the Claims**

In the Office Action mailed on 04/12/2006, the Examiner has objected to the language "restraining the radial movement" in the element second to last of claim 1. Accordingly, Applicant has amended the element second to last of claim 1 to read "preventing the lateral movement."

Applicant submits that the claims, as now amended, patentably distinguish Applicant's invention from the cited references. The withdrawal of the rejection under 35 USC 103(a) is respectfully requested.

### **B. Regarding the Rejection under 35 USC 103(a)**

Should the Examiner be of the opinion that the above amendment to claim 1 insufficient to overcome the Examiner's rejection, Applicant respectfully traverses the rejection of claims 1, 3, 22, and 24 as allegedly obvious over US Patent No. 3,633,611 to MacNiel in view of US Patent 4,257,443 to Turney at least for the following reasons.

The Examiner argues that "[t]he structures [of McNiel and Turney] are taught as equivalent by the fact they have the same purpose. It is not necessary

to take the entire structure of Turney (including the wall mentioned in the remarks).”

1. The McNiel Reference

McNiel teaches an underwater regulator having a poppet that is retained in a centered position during its translation by providing the poppet with a square cross section engaged in a square aperture. *Col. 3, ll. 25–45*. For centering purposes, the poppet is also provided with a head having two square flanges spaced apart.

On the contrary, in Applicant’s invention, the shape of the poppet’s cross-section is irrelevant, except for the ridges or grooves on its surface. In particular, no poppet square cross-section is required, and no head flanges. Therefore, McNiel is not an appropriate reference against Applicant.

2. The Turney Reference

Turney teaches a check valve having a poppet that closes the valve seat, wherein the valve seat is closed by pulling the poppet (provided with a seal ring) against the valve seat. The translation of the poppet is guided by four ridges extending from the terminal sections of four tabs on the poppet. Those ridges move longitudinally within four grooves in the poppet housing and prevent the poppet from translating beyond a predetermined distance away from the valve seat by having a retaining wall operate as a stop-point against the four ridges. *Col. 2, ll. 29–32 and 65–67; Col. 3, ll. 36–40 and 44–54*.

On the contrary, in Applicant's invention, the poppet is free to translate for its entire length.

3. Applicant's Invention Is Not Obvious

Obviousness must be determined in the context of what the prior art fairly teaches; there must be some teaching, suggestion, or incentive of the proposed combination in the prior art for an obviousness rejection to be proper. *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931 (1990); *Ex parte Levensgood*, 28 U.S.P.Q.2d (BNA) 1300 (1993).

Applicant submits that there is no objective teaching or suggestion in McNiel or Turney that would lead one of ordinary skill in the art to combine the teachings of the McNiel with the teachings of Turney to achieve Applicant's invention.

Further, both McNiel and Turney expressly state that the poppet must have some freedom to move laterally, therefore, each of those references teaches away from Applicant's amended claims. McNiel, *Col. 3, ll. 30-31*; Turney, *Col. 2, ll. 65-67*.

4. The Equivalence Argument

In discussing equivalence at §2144.06, the MPEP provides examples of when obviousness by equivalence may or may not apply. In particular, each of the three examples described by the MPEP to prove obviousness by equivalence relates to the obviousness of creating a chemical composition with certain properties by mixing components that individually provide the same properties.

Instead, the four examples provided by the MPEP to disprove obviousness by equivalence relate to situations where “the components at issue are functional or mechanical equivalents.”

As demonstrated above, while both McNiel and Turney are directed at solving the same problem of avoiding poppet rotation as Applicant’s invention, each of those references achieves its purpose with mechanical designs and operation systems that are patentably different from Applicant.

5. Summary

On the basis of the amendments to claim 1 and of the remarks provided above, Applicant respectfully requests that the rejection of claim 1 under 35 USC 103(a) be withdrawn. Because claims 2, 22, and 24 depend on now allowable claim 1 and have no separate grounds for rejection, the allowance of these claims is also respectfully requested.

## CONCLUSION

In view of the amendments and remarks submitted herein, Applicant submits that the present application is in condition for allowance and respectfully requests a notice to that effect.

Should the Examiner require any additional information, the Examiner is invited to contact the undersigned attorney by telephone, fax or e-mail,

Dated: June 16, 2006 Respectfully submitted,

By: /Franco A. Serafini/

Franco A. Serafini

Registration No. 52,207

Attorney for Applicant

Tel.: (858) 456-2898

Fax: (858) 225-3920

E-Mail: franco@patentconcepts.com

SERAFINI ASSOCIATES

7660 Fay Avenue, Suite H378

La Jolla, CA 92037